

Application No. : 10/692,835
Filed : October 23, 2003

REMARKS

Claims 1 – 11, 19 – 32, 43, 53 – 57 and 60 – 69 were pending in the application. By this paper, Applicant has canceled Claims 1 – 11, 19 – 32, 43, 53 – 57 and 60 – 69 without prejudice, and added new Claims 70 – 97. Hence, Claims 70 – 97 are presented for examination herein.

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§112 Rejections

Claim 43 – Per page 2 of the Office Action, Claim 43 stands rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Applicant traverses the Examiner's assertion and specifically points to, page 25, line 21 through page 26, line 8 which sets forth in relevant part:

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"As previously referenced, the present invention also optionally uses one or more specially constructed insert ("contour") pads 321 disposed in the rear region 323 of the pad 300 (see Fig. 3d). In the exemplary embodiment, these pads 321 are disposed laterally to the spine 310 as previously described, and are further tapered in shape to create a wedge-like appearance...."

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In the exemplary embodiment of Fig. 3f, two separate forward inserts 320a, 320b, one for each side, are made from a closed-cell visco-elastic foam material. In the illustrated embodiment, the insert pad elements 320 are formed of a visco-elastic foam material of the type well known in the art...."

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Further, Applicant directs the Examiner's attention to Fig. 3d which clearly shows these two separate and distinct elements being utilized in differing locations in addition to their respective advantages being disclosed at page 27, lines 5 – 17 of Applicant's specification as filed. Hence, Applicant submits that the aforementioned Claim language of Claim 43 is clearly enabled by Applicant's disclosure. Claim 43 has however been cancelled without prejudice, thereby rendering the Examiner's rejection moot. However, in the interest of clarifying other claims which may have similarly recited features, Applicant respectfully directs the Examiner's attention to the above-referenced citations.

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§102 Rejections

Claims 1 – 2, 4, 6 – 7, 9 – 11, 19 – 20, 22 – 25, 27 – 29, 31 – 32, 43, 53 – 57, 60 – 63 and 66 – 69 – Per page 2 of the Office Action, Claims 1 – 2, 4, 6 – 7, 9 – 11, 19 – 20, 22 – 25, 27 – 29, 31 – 32, 43, 53 – 57, 60 – 63 and 66 – 69 stand rejected under 35 U.S.C. 102(b) as being

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anticipated by Vasko et al. (U.S. Pat. No. 4,683,709, hereinafter "Vasko"). Applicant has herein canceled the aforementioned Claims without prejudice thereby rendering the Examiner's rejection moot.

5 §103 Rejections

Claims 3, 5, 8, 21, 26, 30, 64 and 65 – Per page 11 of the Office Action, Claims 3, 5, 8, 21, 26, 30, 64 and 65 were rejected under 35 U.S.C. 103 as being unpatentable over either Vasko or Vasko in view of Woods (U.S. Pat. No. 5,802,823). Applicant has herein canceled Claims 3, 5, 8, 21, 26, 30, 64 and 65 without prejudice thereby rendering the Examiner's rejection moot.

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New Claims

Applicant submits herein new Claims 70 – 97. Support for the newly added Claims are replete throughout the specification as filed. Further, specific support for the newly added independent Claims can be found in the following citations.

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Claim 70 – The subject matter of New Claim 70 generally corresponds to subject matter claimed in previously presented Claims 1 and 3 and subject matter disclosed at page 14, lines 15 – 20 of Applicant's specification as filed. Applicant submits that newly added Claim 70 also distinguishes over the prior art, including Vasko, as Claim 70 includes limitations directed to a first pad and a second pad that straddle the spinal column of the living subject and are sufficiently distant therefrom so that the saddle pad apparatus does not impede movement of the spinal column of the living subject by forming a space between the spinal column and the saddle pad apparatus. Contrast this with the teachings of Vasko, which provides in pertinent part at Col. 3, lines 24 – 31 that:

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"The pockets are located immediately adjacent to and on each side of the centerline 26 so as to hold the inserts 36 and 38 parallel to and in immediate proximity to the horse's spine. This allows the load of the rider and the accompanying shock or energy transfers to be evenly distributed along the horse's back avoiding any undue abrasion of the thoracic spinal vertebrae." {emphasis added}

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Hence, Applicant believes that Vasko *teaches away* from not impeding movement of the spinal column of the living subject, and actually intends to reduce undue abrasion of the spinal

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column by evenly distributing the load along the horse's back, and not by straddling the spinal column so that the saddle pad apparatus does not impede movement of the spinal column as claimed by Applicant. Vasko clearly emphasizes the immediate proximity of the pads to the spinal column of the horse's back and thus, in Applicant's view, Vasko clearly does not
5 contemplate or suggest, *inter alia*, forming a space between the saddle pad apparatus and the spinal column of a living subject as claimed by Applicant.

Claim 80 – The subject matter of New Claim 80 generally corresponds to subject matter claimed in previously presented Claims 19, 20 and original Claims 24 and 26.

10 **Claim 87** – The subject matter of New Claim 87 generally corresponds to subject matter claimed in previously presented Claim 29 and original Claim 30.

Claim 89 – The subject matter of New Claim 89 generally corresponds to subject matter
15 claimed in previously presented Claim 32 and original Claims 61 and 26.

Claim 90 – The subject matter of New Claim 90 generally corresponds to subject matter claimed in original Claims 43, 61 and 26.

20 **Claim 94** – The subject matter of new Claim 94 generally corresponds to subject matter claimed in previously presented Claim 60 and original Claims 61 and 26. Applicant submits that Claim 94 distinguishes over the prior art as none of the prior art, including Vasko, teaches or suggests, *inter alia*, "said pad elements and said pad cooperatively form a raised feature element to raise a frontal portion of a saddle disposed over top of said pad element with respect to a
25 withers region in order to mitigate tilting or rocking of the saddle." Applicant notes that on page 8 of the Office Action, a similar limitation was argued by the Examiner with regards to previously presented Claim 60. Specifically, the Examiner appears to point to element 12 as teaching such.

30 Applicant traverses this assertion, and notes that element 12 of Vasko generally refers to the saddle pad apparatus of Vasko, and not to any particular discussed feature. Applicant notes that Vasko does not appear to teach or even remotely discuss any sort of identifiable raised feature element that raises a frontal portion of a saddle with respect to a withers region in order to mitigate tilting or rocking of the saddle.

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Moreover, Applicant notes that “[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the ‘subject matter as a whole’ which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.” In re Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). {emphasis added} See MPEP 2141.02; “The court found the inventor discovered the cause of moisture transmission was through the center plug, and there was no teaching in the prior art which would suggest the necessity of selecting applicant’s plug material which was more impervious to liquids than the natural rubber plug of the prior art.” None of the art cited by the Examiner, including Vasko, recognizes the problem Applicant’s inventions of Claim 94 seek to address; i.e., mitigation of rocking or tilting, especially in conjunction with a lack of withers protection. Accordingly, this provides yet another basis for patentability of Applicant’s claimed invention.

Claim 96 – The subject matter of New Claim 96 generally corresponds to subject matter claimed in previously presented Claims 63 and 64 and original Claim 65.

Commercial Success Declaration

Applicant submits herewith a revised Declaration Under 37 C.F.R. § 1.132 by Martine Fennelly, inventor of the present applicant, for commercial success of the inventions claimed in Claims 70, 73-74, 76-78, 80, 83-86, 87, 89, 90, 94 and 96 as presented herein. Applicant notes that “[e]vidence rising out of the so-called ‘secondary considerations’ must always when present be considered en route to a determination of obviousness.” See MPEP Section 716.01(a). Hence, Applicant submits that the enclosed Declaration clearly supports Applicant’s contention that the inventions of these Claims are non-obvious over the art of record.

Claim 70 – As discussed above, Applicant does not believe that Vasko anticipates, nor renders obvious Applicant’s new Claim 70 for at least the reasons highlighted above. Applicant thus believes that a declaration in support of the non-obviousness of the claimed features of Claim 70 is wholly appropriate at this time, and in fact must be considered per MPEP Section 716.01(a).

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Claims 80, 87, 89, 90, 94 and 96 – Applicant notes that each of the aforementioned Claims includes limitations directed to, *inter alia*, sheepskin. Applicant notes that the Examiner has previously stated that Vasko is silent about the inclusion of sheepskin disposed in contact with the skin of a living subject (See e.g. paragraph 7 of the Office Action). Hence, Applicant
5 submits that the Examiner has not met his *prima facie* burden for showing every element explicitly or inherently within a single prior art reference as required under the Section 102 anticipation standard, and hence a declaration in support of the non-obviousness of the claimed features is wholly appropriate at this time, and in fact must be considered per MPEP Section 716.01(a).

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Other Remarks

Applicant hereby specifically reserves the all rights of appeal (including those under the Piolt Appeal Brief program), as well as the right to prosecute claims of different or broader scope (including those of non-elected inventions) in a continuation or divisional application.

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Applicant notes that any claim cancellations or additions made herein are made solely for the purposes of more clearly and particularly describing and claiming the invention, and not for purposes of overcoming art or for patentability. The Examiner should infer no (i) adoption of a position with respect to patentability, (ii) change in the Applicant's position with respect to any claim or subject matter of the invention, or (iii) acquiescence in any way to any position taken by
20 the Examiner, based on such cancellations or additions.

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Furthermore, any remarks made with respect to a given claim or claims are limited solely to such claim or claims.

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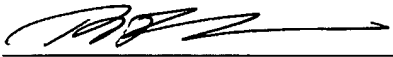
If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call the undersigned at (858) 675-1670.

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Respectfully submitted,
GAZDZINSKI & ASSOCIATES

Dated: 11/30/06

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